

## **REMARKS**

Claims 1-48 and 53-62 are pending.

Claims 1, 2, 4, 5, 8, 9, 14-17, 19, 28-48, and 53 have been amended.

Claims 10 and 11 have been canceled without prejudice or disclaimer of the subject matter recited therein.

### **Claim Rejections - 35 U.S.C. § 101**

Claims 1-48 and 53-62 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 has been amended to recite “A document-generation process performed using a computer system, the process comprising:”. Applicant respectfully submits that performing a process with a computer system represents statutory subject matter under 35 U.S.C. § 101. Claims 2-7, which directly or indirectly depend upon claim 1, inherit the amendment to claim 1 through their respective recitation of “A document process as defined in Claim [1 or a chain dependency to claim 1].

Claim 8 has been amended to recite “A method of generating customized versions of a document using a computer system, the method comprising”. Applicant respectfully submits that performing a method with a computer system represents statutory subject matter under 35 U.S.C. § 101. Claims 10-13 and 15-27, which directly or indirectly depend upon claim 8, inherit the amendment to claim 8 through their respective recitation of “A method as defined in Claim [8 or a chain dependency to claim 8].

Claim 28 has been amended to recite “A computer readable medium having data stored therein to cause a data processing system to generate a data document generated according to a process comprising:”. Applicant respectfully submits that a computer readable medium having data stored therein to cause a data processing system to generate a data document represents statutory subject matter under 35 U.S.C. § 101. Claims 29-48, which directly or indirectly depend upon claim 28, inherit the amendment to claim 29 through their respective recitation of “A method as defined in Claim [28 or a chain dependency to claim 28].

Claim 53 has been amended to recite “A method of generating customized versions of a document using a computer system, the method comprising:”. Applicant respectfully submits that a method of generating customized versions of a document using a computer system represents statutory subject matter under 35 U.S.C. § 101. Claims 29-48, which directly or indirectly depend upon claim 28, inherit the amendment to claim 29 through their respective recitation of “A method as defined in Claim [28 or a chain dependency to claim 28].

Applicant respectfully submits that Claims 58-62 each represent a new and useful machine and, thus, represent statutory subject matter under 35 U.S.C. § 101. Courts have found certain exceptions. “Excluded from such patent protection are laws of nature, physical phenomena, and abstract ideas.” *Diamond v. Diehr*, 450 U.S. 175, 185, 209 USPQ 1, 7 (1981). Applicant respectfully submits that “first database means”, “first tabular means for storing document records”, “an interface coupling the first database means to the first tabular means”, “second database means”, “second tabular means”, and “an interface” clearly do not read on a laws of nature, physical phenomena, or abstract ideas. The Board of Patent Appeals and Interferences has stated that “there is currently no judicially recognized separate “technological arts” test to determine patent eligible subject matter under § 101.” *Ex Parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005). Accordingly, Applicant respectfully submits that Claims 58-62 each represent a new and useful machine and, thus, represent statutory subject matter under 35 U.S.C. § 101.

In view of the amendments and remarks set forth above, Applicant respectfully requests withdrawal of the rejection.

## Claim Rejections - 35 U.S.C. § 103

### I.

Claims 1-48 and 53, 54, and 56-62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Application No. 20020123993 to Chau et al.(referred to herein as “*Chau*”) in view of Application No. 20020013792 to Imielinski et al. (referred to herein as “*Imielinski*”). Applicant respectfully traverses the rejection.

Applicant respectfully submits that *Chau* in combination with *Imielinski* fail to teach or suggest the present invention of claims 1-48 and 53, 54, and 56-62 because neither *Chau* nor *Imielinski* apply one or more transforms to previously transformed data.

*Chau* teaches that “data stored on a data storage device that is connected to a computer is transformed. A query that selects data in the data storage device is received. The selected data is retrieved into a work space. Then, one or more XML documents are generated to consist of the selected data.” *Chau*, para. 0017. Thus, *Chau* teaches **a single transformation**.

*Imielinski* teaches that “The present invention relates to a method and system for transformation of an electronic document through learning transformation rules during training from the original electronic document using visual user feedback and applying the learned transformation rules to either the original electronic document or a second electronic document having a similar structure as the original document or all future instances of the original electronic document.” *Imielinski*, para. 0011.

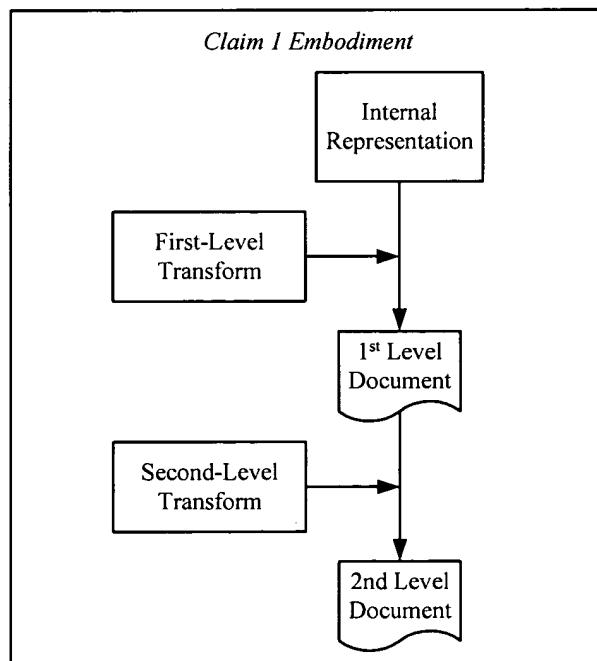
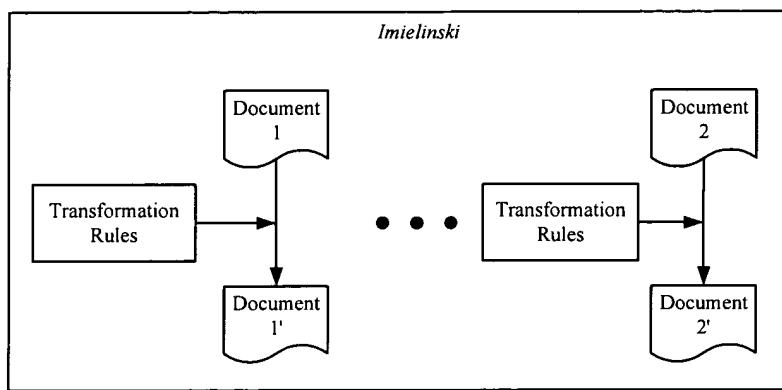
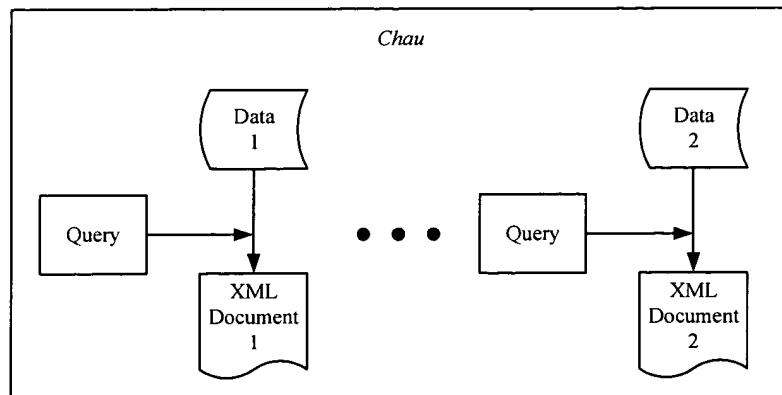
*Imielinski* teaches that transformation rules can be applied to (1) an original document, (2) a second electronic document having a similar structure as the original document, or (3) all future instances of the original document. However, although the transformation rules can be applied to all of these different documents, there is **no teaching** that the transformation rules are applied **to a previously transformed document**. Applicant respectfully submits that the only teaching of “applying the first-level transform to the internal representation so as to create a first-level document” and applying the second-level transform to the first-level document so as to create a second-level document” is found in the present application. Claim 1.

Thus, *Chau* and *Imielinski* teach the transformation of a document. However, neither *Chau* nor *Imielinski*, alone or in combination, teach or suggest:

**“applying the first-level transform to the internal representation so as to create a first-level document” and**

**applying the second-level transform to the first-level document so as to create a second-level document.”** Claim 1.

Applicant presents illustrations on the following page of *Chau* and *Imielinski* that Applicant believes accurately represent the relevant teachings of *Chau* and *Imielinski*. Applicant has also presented an example embodiment of the elements of claim 1 discussed above. Note, the illustration is only one embodiment and is not intended to limit the scope of claim 1.



The distinctions between the combined teachings and suggestions of *Chau* and *Imielinski* and the present invention are **non-trivial**. For example, the Present Application states, “The transformation of an initial document into a final document may be decomposed into a series of sequential transforms.” Present Application, p. 8, lines 8-9. “Decomposition simplifies the creation, validation and maintenance of the transforms.” *Id.*, lines 9-10. Note, the present invention is defined by the claims and not be specific embodiments in the Present Application.

Applicant respectfully submits that there are no teachings or suggestions to motivate one of ordinary skill in the art to simply add the transforms in *Chau* and *Imielinski* to arguably suggest the present invention. Applicant also respectfully submits that any such suggestion can only come from hindsight in view of the present application. Hindsight is an impermissible basis for establishing a *prima facie* case of obviousness. W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1551, 220 USPQ 303, 312-13 (Fed. Cir. 1983). To prevent a hindsight-based obviousness analysis, the Federal Circuit has clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to select and modify *Chau* in accordance with *Imielinski* so as to render the present invention obvious under 35 U.S.C. § 103. The Federal Circuit in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d (BNA) 1686 (Fed. Cir. Jan. 29, 2004) stated that:

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention. Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an "as a whole" assessment of the invention under § 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination.

Following the analogy of *Ruiz*, Applicant respectfully submits that *Chau* in combination with *Imielinski* do not even teach “A” and “B”. Applicant submits that *Chau* in combination with *Imielinski* relevantly teach only “A”. Accordingly, Applicant respectfully submits that claim 1 is allowable over *Chau* in combination with *Imielinski*.

**Claims 8, 28, 53, and 58.**

For reasons at least similar to those of claim 1 presented above, Applicant respectfully submits that neither *Chau* nor *Imielinski*, alone or in combination, teach or suggest the present invention of claims 8, 28, 53, and 58.

As stated above and restated here for the Examiner’s convenience, *Chau* teaches that “data stored on a data storage device that is connected to a computer is transformed. A query that selects data in the data storage device is received. The selected data is retrieved into a work space. Then, one or more XML documents are generated to consist of the selected data.” *Chau*, para. 0017.

*Imielinski* teaches that “The present invention relates to a method and system for transformation of an electronic document through learning transformation rules during training from the original electronic document using visual user feedback and applying the learned transformation rules to either the original electronic document or a second electronic document having a similar structure as the original document or all future instances of the original electronic document.” *Imielinski*, para. 0011.

*Imielinski* teaches that transformation rules can be applied to (1) an original document, (2) a second electronic document having a similar structure as the original document, or (3) all future instances of the original document. However, although the transformation rules can be applied to all of these different documents, there is **no teaching** that the transformation rules are applied **to a previously transformed document**.

Thus, *Chau* and *Imielinski* teach the transformation of a document. However, neither *Chau* nor *Imielinski*, alone or in combination, teach or suggest:

**Claim 8:**

“decomposing the document, wherein decomposing the document comprises **applying a first-level transform to the internal representation of the document so as to create a first-level document** and **applying a second-level transform to the first-level document so as to create a second-level document.**”

**Claim 28:**

“decomposing the document into a form requested by a recipient of the document, wherein decomposing the document comprises **applying a first-level transform to the internal representation of the document so as to create a first-level document** and **applying a second-level transform to the first-level document so as to create a second-level document.**”

**Claim 54:**

“**transforming the document from primitive form into an internal representation of the document;**  
**transforming the internal representation into at least one subscription-level document, into a DEFAULT organization-level document and into at least one user-specific organization-level document;**

**transforming the DEFAULT organization-level document into at least one presentation-level document; and**

**transforming the user-specific organization-level document into at least one presentation-level document.”**

**Claim 58:**

second database means for storing a compilation of transforms that enable an **internal representation of a document to be transformed into a first-level document** and that enable the **first-level document** to be transformed **into a second-level document.**

Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claims 1, 28, 54, and 58. For at least the same reasons, Applicant also respectfully requests withdrawal of the rejection of claims directly or indirectly dependent upon independent claims 1, 28, 54, and 58.

## II.

Claim 55 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chau in view of Application No. 20020013792 to Imielinski et al. (referred to herein as “*Imielinski*”) and further in view of U.S. Patent No. 5,893,109 issued to DeRose et al..

Claim 55 depends upon claim independent claim 54. Applicant respectfully requests withdrawal of the rejection of claim 54 for at least the same reasons as independent claim 54.

## CONCLUSION

In view of the amendments and remarks set forth herein, Applicant respectfully submits that all pending claims are in condition for allowance. Accordingly, Applicant requests that a Notice of Allowance be issued. Nonetheless, should any issues remain that might be subject to resolution through a telephone interview, the Examiner is requested to telephone the undersigned at 512-338-9100.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450, on December 2, 2005.



Attorney for Applicant(s)

12-2-2005  
Date of Signature

Respectfully submitted,



Kent B. Chambers  
Attorney for Applicant(s)  
Reg. No. 38,839